

REMARKS

This RCE and preliminary amendment is provided in reply to a Final Office Action mailed **August 28, 2006**. In the Action, pending claims 1-28 were rejected under 35 USC §101, 35 USC §102(b) and 35 USC §103(a) as detailed below. The Action contends that claims 4-7, 8-10, 12, 13, and 15-17 are not entitled to the priority date of the provisional application 60/397,524. Also, the Examiner objected to the drawing(s) filed on July 22, 2003.

With this amendment, base claims 1, 11, and 24 have been amended. New claims 29-40 have been added. No claims have been cancelled. Patentee submits corrected drawings concurrently with this response to overcome Examiner's objection. Accordingly, claims 1-40 are pending with this application. In view of the foregoing amendment and the following remarks, reconsideration of the above-captioned application is respectfully requested.

Priority

In **paragraph 38** of the Action, Examiner points out that the Patentee failed to claim priority based upon any of the related applications cited in paragraph [0002] of the specification. In response, Patentee submits the foregoing amendment to the specification.

Please replace paragraph [0001] of the specification with the foregoing replacement paragraph provided in the section designed "Amendments to the Specification." It is noted that no new matter is entered by the amendment and that no prosecution history estoppel results. Therefore, it is requested that the Examiner withdraw his position with respect to a lack of adequate support for the claims pending in the present patent application.

§101 Rejection of Claims 1-6, 11-13 and 17-28

In **paragraph 9** of the Action, claims 1-6, 11-13, and 17-28 were rejected under 35 USC §101 because, according to the Examiner, the claimed subject matter is allegedly directed to non-statutory subject matter. In response to the §101 rejection of claims 1, 11, and 24, Patentee respectfully traverses the rejection.

Base claims 1, 11, and 24 are directed to the technological arts and are statutory, even under the recent BPAI opinion Ex Parte Bilski (Appeal No. 2002-2257), mailed September 26, 2006. More specifically, the USPTO guidelines regarding non-statutory subject matter specifically state in section 2106:

“[t]o be statutory, a claimed computer-related process must (B) be limited to a practical application within the technological arts.”

It is respectfully asserted that this PTO requirement is satisfied here. Bilski, for example, defines “technology” as “the application of science and engineering to the development of machines and procedures in order to enhance or improve human conditions, or at least improve human efficient in some respect.” It is asserted that this standard is met here. Thus, the claims clearly fall within the category of the technological arts, even applying the definition from Ex Parte Bilski.

If the USPTO’s guidelines were not sufficient, furthermore, the claims at issue involve a machine-implemented process, which is statutory based upon the well-known Federal Circuit cases *State Street* and *AT&T. AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998). Thus, it appears that there is no question that the claims here comprise statutory

subject matter.

Patentee further traverses the basis for the §101 rejection of base claim 24. Claim 24 discloses, in part, a "...processor program being stored on a processor readable medium..." A claimed processor-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components, which permit the data structure's functionality to be realized. In this regard, the subject matter of claim 24 again provides the recitation of a tangible result and is *statutory*.

Accordingly, Patentee respectfully requests that the §101 rejection of claims 1, 11, and 24 be withdrawn. Claims 2-6, 12-13, and 17-23 depend from base claims 1 and 11 respectively. Claims 25-28 depend from base claim 24. Thus, Patentee submits that claims 2-6, 12-13, 17-23, 25-28 are likewise statutory and respectfully requests that the rejection of such claims be withdrawn.

§102(b) Rejection of Claims 1-9, 11-16, and 18-28

In **paragraph 13** of the Action, claims 1-9, 11-16, and 18-28 were rejected under 35 USC § 102(b) as being anticipated by Rivette et al. (U.S. Patent 6,339,767), hereafter "Rivette." In response, Patentee respectfully traverses the basis of such rejection. For at least the reasons set forth below, Patentee submits that claims 1-9, 11-16, and 18-28 are not anticipated by the Rivette document.

The amended claims are at least distinguishable over the cited Rivette document. The Manual of Patent Examining Procedure ("MPEP"), in § 2131, states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in

the ... claim.” *Richardson v. Suzuki Motor Co.*, 869 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Thus, under 35 U.S.C. § 102, a claim is anticipated *only if* each and every element of the claim is found in the cited document. Also, the cited document must show the claimed subject matter in as complete detail as recited in the claim.

Amended base claim 1 recites:

1. A method of searching a database of data elements, the method comprising: based on a starting data element, identifying a first set of one or more data elements in the database, the data elements of the first set being referenced by the starting data element, based on the first set, identifying a second set of one or more data elements in the database, the data elements of the second set referencing one or more of the data elements of the first set, generating data based on the data elements of the first and second sets and the relationships therebetween;

the second set being identified by recursive searching, without user intervention, in which any successive search is capable of being contracted, expanded and/or otherwise modified to include one or more generations of interrelated data elements.

The Office Action directs the Patentee’s attention to Rivette (col. 88, line 65 – col. 89, line 21), wherein a patent citation report can be performed and displayed in a recursive fashion with an operator specified depth.

However, the Rivette document discloses a patent citation report that relies on an *operator to specify the level or depth of the report* (see Rivette; col. 88, lines 65-67). Rivette discloses that “The present invention can support patent citation reports of *any operator specified level...*” (see Rivette; col. 89, lines 9-11) [emphasis added]. However, the cited Rivette passages fail to show or disclose a second set of data being identified by recursive searching, *without user intervention*, as claimed in amended claim 1. Here, subject matter claimed allows the depth or level of searches to be independent of operator intervention, contrary to what is disclosed in Rivette.

Rivette at least fails to disclose a second set of data being identified by recursive searching, without user intervention. In at least this regard, base claim 1 is distinguishable from

the cited Rivette document. Accordingly, Patentee respectfully requests that the 102(b) rejection of base claim 1 be withdrawn.

Claims 11 and 24 contain similar limitations to claim 1 and patentably distinguish on at least a similar basis. Furthermore, claims 2-9 depend from claim 1, claims 12-16 and 18-23 depend from claim 11, and claims 25-28 depend from claim 24. Patentee submits that claims 2-9, 11-16, and 18-28 are therefore likewise not anticipated by Rivette. It is therefore requested that the Examiner withdraw his rejection of these claims on this basis.

§103(a) Rejection of Claims 10 and 17

In **paragraph 35**, claims 10 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivette in view of Coleman et al. ("Aesthetics-Based Graph Layout for Human Consumption"). For at least the reasons set forth below, Patentee submits that such claims are not rendered obvious by the cited documents.

As is well-known, "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." See MPEP § 2143.

Thus, the cited documents, whether considered individually or in combination, must teach or suggest all of the claim limitations of the rejected claims. However, previously, it was noted that Rivette fails to disclose or show each and every element of the rejected claims. Likewise, Coleman fails to cure the deficiency noted above with respect to Rivette. Therefore, without addressing whether or not a combination of Rivette and Coleman is proper, it is nonetheless asserted that the combination would fail to provide all of the elements of the rejected claims. Thus, the Patentee respectfully requests that the rejection of such claims be withdrawn.

Failure of the Patentee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the Examiner with which Patentee does not agree in this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed **August 28, 2006**. In view of the foregoing amendment and remarks, Patentee respectfully submits that pending claims are in condition for allowance and a notification of such allowance is respectfully requested.

Should it be determined that an additional fee is due, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account **50-3130**.

If the Examiner believes that there are any remaining informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

Respectfully submitted,

Dated:

2/27/07



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